## REMARKS

Claims 15 and 16 are pending in this application. No new matter is added.

In support of the remarks and arguments stated *infra*, Applicants have submitted herewith the Declaration of Dr. Howard B. Haimes and enclosed courtesy copies of the references cited for consideration by the Examiner.

## CLAIM REJECTIONS

### 35 U.S.C. § 112 Rejection

Claims 15 and 16 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner states that the specification does not support a method of treating, ameliorating or preventing hypertension or systolic hypertension by administering the claimed combination as the Examiner alleges the specification does not provide "blaze marks" directing the skilled artisan to Applicants specifically claimed combination (*i.e.*, 3-(2-phenyl-2-oxoethyl)-4,5-dimethylthiazolium chloride/bromide with hydrochlorothiazide, for use in the treatment or prevention of isolated systolic hypertension). *See*, Office Action at page 3. Applicants traverse.

In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide in *haec verba* support for the claimed subject matter at issue. Fujikawa v. Wattanasin, 93 F.3d 1559, 39 U.S.P.Q.2D (BNA) 1895 (Fed. Cir. 1996). If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 19 U.S.P.Q.2D (BNA) 1111 (Fed. Cir. 1991).

The Examiner points Applicants to Purdue Pharma L.P. v. Faulding, Inc., 56 USPQ2d 1481, 1486 (Fed. Cir. 2000) to support the position that the instant specification does not provide "blaze marks" in support of pending claims 15 and 16. Applicants submit

that facts regarding the sufficiency of the disclosure of the specification in Purdue Pharma L.P. are distinguishable from the facts regarding the sufficiency of the disclosure of the instant application. It is established that the inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

The claims at issue in Purdue Pharma L.P. were directed to specific range limitations (Cmax/C[24]) for an oral sustained release dosage form where the disclosure of the 5,672,360 patent only disclosed a multitude of pharmacokinetic parameters, with no "blaze marks" directing the skilled artisan to the Cmax/C[24] ratio or what value that ratio should exceed. The Purdue Pharma L.P. court stated "[T]he specification does not clearly disclose to the skilled artisan that the inventors... considered the... ratio to be part of their invention.... There is therefore no force to Purdue's argument that the written description requirement was satisfied because the disclosure revealed a broad invention from which the [later-filed] claims carved out a patentable portion". Purdue Pharma L.P. at 1326, 1328.

The court in Purdue Pharma L.P. cited the decision and reasoning of its predecessor court in the case of In re Ruschig, 54 C.C.P.A. 1551, 379 F.2d 990, 154 U.S.P.Q. (BNA) 118 (CCPA 1967). The claim at issue in In re Ruschig was directed to a single compound. The applicants argued that, although the compound itself was not disclosed, one skilled in the art would find support for the claimed compound in the general disclosure of the genus of compounds to which the claimed compound belonged. The Ruschig court rejected that argument, stating that "it is an old custom in the woods to mark trails by making blaze marks on the trees. It is of no help in finding a trail or in finding one's way through the woods where the trails have disappeared--or have not yet been made, which is more like the case here--to be confronted simply by a large number of unmarked trees. We are looking for blaze marks which single out particular trees. We see none." In re Ruschig at 994-995.

The court in Purdue Pharma L.P. went on to state that "specific claims to single compounds require reasonably specific supporting disclosure and while we agree with the appellants, as the board did, that naming is not essential, something more than the disclosure of a class of 1000, or 100, or even 48, compounds is required." As Ruschig makes clear, one cannot disclose a forest in the original application, and then later pick a

tree out of the forest and say "here is my invention." In order to satisfy the written description requirement, the blaze marks directing the skilled artisan to that tree must be in the originally filed disclosure. Purdue Pharma L.P. at 1326-1327.

As stated *supra*, Applicants submit the instant facts are distinguishable from the facts of Purdue Pharma L.P. and Ruschig. To analogize the facts of Purdue Pharma L.P. and Ruschig to the instant application, Applicants specification, as originally filed, would be required to only disclose the broad combination of thiazoliums and diuretics to treat or prevent isolated systolic hypertension and then claim a specific thiazolium, 3-(2-phenyl-2-oxoethyl)-4,5-dimethylthiazolium salt (*i.e.*, chloride or bromide), in combination with a specific diuretic, hydrochlorothiazide, without the specification reciting either of these specific compounds. This is not the case.

Applicants submit that page 18, line 21 - page 19, line 31 and page 21, line 23 - page 22, line 11 (more specifically page 22, lines 8-11) of instant specification as filed provides sufficient written description for pending claims 15 and 16. Specifically, page 18, line 21 - page 19, line 31 (more specifically page 19, lines 8-10) provide sufficient written description for **first** agents of the invention (*i.e.*, 3-(2-phenyl-2-oxoethyl)-4,5-dimethylthiazolium salt) to treat, ameliorate or prevent isolated systolic hypertension and further provide support that the first agents of the invention can be combined with additional (*e.g.*, second) agents ("**Emphasis Added**"). Moreover, page 21, line 23 - page 22, line 11 (more specifically page 22, lines 8-11) provide written description for first agents for administration or in a combined formulation with second agents (*i.e.*, diuretics) with a preferred diuretic being hydrochlorothiazide (page 22, line 3).

As such, Applicants submit that the specification as originally filed does not just disclose a broad class of compounds (a forest); but in fact, the specification provides specific "blaze marks" to direct one of ordinary skill in the art to the specific combination of 3-(2-phenyl-2-oxoethyl)-4,5-dimethylthiazolium salt (*i.e.*, chloride or bromide) and hydrochlorothiazide (the trees) to treat isolated systolic hypertension.

Applicants further disagree with the Examiner's assertion that the specification supports these combinations only for the treatment of heart failure, cardiomyopathy or heart attack. A written description analysis must take into account whether the limitations are explicitly or inherently supported by the original disclosure. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Reynolds, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); In re Smythe, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973). What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 USPQ 81. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); Ralston Purina Co. v. Far-Mar-Co., Inc., 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985).

Using references available on the filing date of the instant application, one of ordinary skill in the art would readily recognize that the essential manifestation of the disorders indicated by the Examiner (*i.e.*, heart failure, cardiomyopathy or heart attack) is isolated systolic hypertension (Kannel et al., *N. Eng. J. Med.* 287: 781-787, 1972; Goss et al., *Arch. Intern. Med.* 124: 160-164, 1969; Rabkin et al. *Ann. Intern. Med.* 88: 342-345, 1978; Kannel et al., *J. Am Med. Assoc.* 245: 1225-1229, 1981; Multiple Risk Factor Intervention Trial Research Group, *J. Am Med. Assoc.* 248: 146-147, 1982; Smulyan and Safar, *Ann. Intern. Med.* 132: 233-237, 2000). Thus, Applicants submit that based on the state of the art at the time of filing and the disclosure in the specification at page 18, line 21 - page 19, line 31 and page 21, line 23 - page 22, line 11 one of ordinary skill in the art would readily conclude that at the time the application was filed, Applicants had possession of the invention as claimed. *See*, Haimes Declaration ¶ 4.

Applicants respectfully request withdrawal of the present rejection.

## CONCLUSION

On the basis of the foregoing amendment and remarks, Applicants respectfully submit that the pending claims are in condition for allowance and a Notice of Allowance for the pending claims is respectfully requested. If there are any questions regarding this application that can be handled in a phone conference with Applicants' Attorneys, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

Ivor R. Elrifi, Reg. No. 39,529
Matthew Pavao, Reg. No. 50,572
Attorney/Agent for Applicants
c/o Mintz, Levin
Telephone: (617) 542 6000
Fax: (617) 542 2241
**Customer No.: 30623**

Dated: October 5, 2005

TRA 2075754v1